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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,627	03/29/2001	Stephen P. Laurie	SPL2001-001	4129

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EXAMINER

RETTA, YEHDEGA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/821,627

Applicant(s)

LAURIE, STEPHEN P.

Examiner

Yehdega Retta

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*MLW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological art; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical science as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

The independently claimed steps of issuing initial offer price, receiving input and issuing an incremental discount price do not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory patent protection. The claimed step of initial and receiving does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of user or by use of a pencil and paper. Claims reciting those steps can be performed by interpersonal communications such that the claimed steps can be performed without a physical structure or

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mechanical object. The method only constitutes an idea for issuing an incremental discount price.

Additionally, for a claimed invention to be statutory the claimed invention must produce a useful, concrete and tangible result. In the present case, the claimed invention produces discount to a buyer (i.e., repeatable) prediction (i.e., useful and tangible). Although the recited process produces a useful, concrete and tangible result, since claimed invention, as a whole, is not with the technological art as explained above, the claims are deemed to be directed to non-statutory matter. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 1-4, 6-9, 11-17, 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. U.S. Patent No. 6,443,843.

Regarding claims 1-4, Walker teaches issuing an initial offer price, receiving a choice to either accept the offer and make a purchase of the product or service at the offered price or to play for lower price; responsive to receiving a choice to play for lower price issuing an incrementally discounted price ..., allowing customer to purchase the product at a full price upon termination of play, wherein the play is randomly terminated within predetermined bound (see col. 11 line 50 to col. 12 line 62, col. 14 lines 23-61 and col. 15 line 1 to col. 16 line 13).

Claims 6-9 and 14-17 are rejected as stated above in claims 1-4.

Regarding claims 11-13 and 20-25, Walker teaches bidding device comprising of point-of-sale, or web browser computer or server, telephone or vending machine; offering system comprising of an automated attendant program code (col. 3 line 60 to col. 6 line 54 and col. 13 lines 25-38).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 10, 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and further in view of Official Notice.

Regarding claims 5, 10 and 18, Walker teaches determining from among several games based on criteria (see col. 14 lines 23-34) however failed to explicitly teach issuing a question

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and responsive to correct answer, offering customer a choice to continue playing. Official Notice is taken that is old and well known in the art of game to offer a game of knowledge such as trivia or quiz game for the purpose of providing player a chance to achieve a higher reward level or better payouts. Therefore, it would have been obvious to one of ordinary skill in the art to include such type of games in order to entice player to play more.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Webb et al. U.S. Patent No. 6,632,141 teaches game device having an offer an acceptance selection bonus scheme with a terminator and an anti-terminator.

Jaffe et al. U.S. Patent No. 6,443,837 teaches bonus games for gaming machines with strategy options.

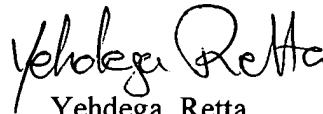
Walker et al. U.S. Patent No. 6,193,606 teaches a game of knowledge for enhanced payouts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Yehdega Retta".

Yehdega Retta  
Primary Examiner  
Art Unit 3622

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